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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,504	07/01/2003	Steven C. Shanks	206-038	3500

33354 7590 09/28/2006

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EXAMINER

JOHNSON III, HENRY M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/612,504	Applicant(s) SHANKS ET AL.	
	Examiner Henry M. Johnson, III	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13-30, 32 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) 35-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13-30 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>110905</u> | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's Appeal Brief filed August 2, 2006 is acknowledged. Prosecution on the merits of this application is reopened and the finality of the office action of November 10, 2005 is withdrawn. Lai et al. teach a specific embodiment without an adhesive ring (Fig. 2) that is clearly capable of being freely moved by a hand while radiating. Lai et al. therefore, does not teach away from moving the wand by hand. A new office action is provided herein. One skilled in the art as used by the examiner, includes both the laser art and optics as lasers in the medical area most commonly use optics.

Election/Restrictions

Newly submitted claims 35-39 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Surgical methods are classified in 128/898 while light therapeutic devices are classified in 607/89.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 35-39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 8-10, 13-15 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,074,411 to Lai et al. Lai et al. teach a multiple laser diode apparatus for therapy using multiple probes (Fig. 1), each with a laser diode with a wavelength between 500 and 1500 nanometers operating at about 5 mW (Col. 2, lines 42-45) and the probe is disclosed as having focusing optics (Col. 2, lines 32-35). The wavelength range includes visible, red and infrared wavelengths. Lai teaches an embodiment with an adhesive (Fig. 1) and an embodiment with just a laser probe (Fig. 2). The second embodiment is clearly capable of being moved by an operator's hand while in operation with no other supporting structure. The control unit is interpreted as a base unit. The focusing optics are an optical arrangement and any optical element will result in some transformation of the beam as that is the reason for using such an element. The resultant beam will have some shape, although no specific shape is claimed.

Regarding claim 2, the destination of the beams is intended use with no further limitation on the device structure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 13-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,267,779 to Gerdes in view of U.S. Patent to Zavislan et al.

Gerdes discloses an apparatus for therapeutic laser treatment that includes handheld wands (Fig. 7) that each may deliver two wavelengths of laser energy, one in the near infrared range and the other in the visible range (Col. 8, line 54) from solid-state diode lasers (Col. 7, lines 22-24). The beams are combined and delivered to the wands that include adjustable optics to focus and shape the beams (Col. 8, lines 31-34). The beam shape may be circular or rectangular (Col. 9, line 49), or a variety of other patterns. This is interpreted as anticipating the various shapes claimed as a skilled artisan is capable of generating a desired shape and size of the beam and no specific benefit or unexpected result is disclosed for any of the claimed shapes. A controller for the sources is disclosed that may control the pulse parameters, including, continuous or pulsed, pulse duty cycle and duration of application for each of the radiation sources synchronously or independently with continuous operation possible by selection of a duty cycle of 100 percent (Col. 11, lines 3-8). Specifically mentioned is a pulse frequency of one hertz (Col. 11, line 63). The system is capable of emitting radiation at less than one watt; with 0 to 2.0 W specified for the infrared laser diode and 0 to 6 mW specified for the visible laser diode (Col. 9, lines 14 and 31). The wavelength disclosed for the visible beam is 400 to 700 nm (col. 9, line 38), and 900 to 1100 nanometers for the infrared beam (Col. 9, line 27). It is noted that 400 nanometers is the limit of the ultraviolet spectrum, thus teaching radiation in that spectrum. The handheld wands are connected to the radiation sources within the controller cabinet (base) via optical fibers (Col. 8, lines 23-25). Gerdes discloses a mode in which only the two aiming beams are generated (Col. 11, lines 45-50), after which, a routine is executed to determine if operation of the therapeutic laser is proper, thus teaching visible radiation only from the wands. Gerdes does not teach the laser sources within the wand or

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probe. Zavislan et al. teaches a hand held probe for delivery of laser energy to tissue. The laser beam may be provided by a laser external of the housing which is introduced into the housing through an optical fiber cable, an articulated optical delivery arm or by a laser, such as a solid state laser (e.g. a laser diode) which is mounted in the housing. The housing contains optical means for projecting and focusing the beam (Col. 2, lines 62-67). Thus, Zavislan et al. teach the source may be located within or external to the probe. It would have been obvious to one skilled in the art at the time the invention was made to mount the laser diodes in the probe as taught by Zavislan et al. in the invention of Gerdes to eliminate the need for an optical fiber and better control the beam path. Zavislan et al. suggests this mounting and advances in laser technology have reduced the size of laser sources further enabling internal mounting. Note that Lai et al., as discussed above, also teaches internal mounting of laser diodes in a probe.

Regarding claim 30, Gerdes teaches the probes radiate in the visible range of 400 to 700 nanometers, yet does not specifically disclose the radiation of the probes is at different visible wavelengths. One of skill in the art would recognize the need to be able to differentiate the beams from each probe and would therefore provide a means to do so. An obvious means for differentiation would be a different color beam.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,273,884 teaches both internal and externally mounted laser sources.

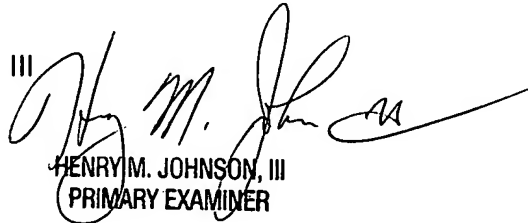
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Henry M. Johnson, III
Primary Examiner
Art Unit 3739



HENRY M. JOHNSON, III
PRIMARY EXAMINER